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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/934,625	08/22/2001	Yoichiro Sako	7217/65197	8670

7590 04/05/2004  
Copper & Dunham LLP  
1185 Avenue of the Americas  
New York, NY 10036

EXAMINER

DINH, TAN X

ART UNIT	PAPER NUMBER
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2653

DATE MAILED: 04/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/934,625

Applicant(s)

SAKO ET AL.

Examiner

TAN X. DINH

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) \_\_\_\_ is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

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1) The preliminary amendment filed 2/14/2003 is acknowledged.

2) The I.D.S filed 2/10/2003 has been considered by the Examiner. However, the Japan and/or foreign document(s), if they have not been written in English, are considered to the extent that could be understood from the English Abstract and the drawings.

Form PTO-1449 or PTO/SB/08 is(are) attached herein.

3) The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The following title is suggested.

OPTICAL RECORDING MEDIUM HAVING FIRST AND SECOND RECORDING  
AREAS OF DIFFERENT FORMATS.

4) Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase " the other addressing system " ( claim 1, line 10; claim 2, line 5; claim 4, line 5; claim 9, line 11; claim 10, line 12; claim 12, lines 8-9; claim 15, line 9; claim 16, line 9 ) render(s) the claim(s) indefinite since it was not clear what applicant intended to cover by the recitation "other addressing system ". The resulting claim(s) do not clearly set forth the metes and bounds of the patent protection desired.

Claim(s) 2-8,11-14 incorporate the indefiniteness of claim(s) 1,9 and 10 by virtue of their dependency thereon.

5) The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

6) (e) the invention was described in:

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7) Claims 1,2,5-10,13-16, as understood by the meaning of 112, 2<sup>nd</sup> above, are rejected under 35 U.S.C. 102(e) as being anticipated by SHIKUNAMI et al ( 6,038,208 ).

SHIKUNAMI et al discloses a data recording medium as claimed in claims 1,2 comprising:

A first recording area for recording data in a first addressing system ( Fig.1, recording area A );

A second recording area for recording data in a second addressing system different with first address system ( Fig.1, recording area B );

Wherein one of first and second addressing systems is converted into the other addressing system ( column 6, line 51 to column 8, line 22 ).

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As to claims 5,6,13 and 14 SHIKUNAMI et al shows the first addressing system each digit of minute, second and frame is represented in BCD notation ( Fig.1, A. The addressing system in recording area A is in CD format, which is used BCD notation ), the second addressing system is represented in binary notation ( Fig.1, B. The addressing system in B area is in binary notation or in BCD notation ).

As to claim 7, the lead-in area (LIA) and lead-out area (LOA) is inherent in every optical recording medium with multiple recording areas.

As to claim 8, SHIKUNAMI et al shows recording density on first and second recording areas are different in column 6, lines 10-59.

Method and apparatus claims 9,10,15 and 16 are drawn to the method and apparatus of using the corresponding recording medium claimed in claim 1. Therefore, method and apparatus claims are rejected for the same reasons of anticipation (obviousness) as used above.

8) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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9) This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10) Claims *3,4,11 and 12* are rejected under 35 U.S.C. 103(a) as being unpatentable over SHIKUNAMI et al (6,038,208) further in view of ITAMI et al (5,684,785).

SHIKUNAMI et al discloses all the subject matter claimed as in claims 3,4,11 and 12, except to specifically shows a non-recording area between first and second recording areas. ITAMI et al from the same field teaches a non-recording area ( boundary area ) between first and second recording areas. Since the method as taught by ITAMI et al is old and well known, it would have been obvious to someone within the level of skill in the art at the time of the invention was made to use a non-recording area between first and second recording areas in SHIKUNAMI et al's optical recording medium as claimed.

11) The prior art made of record and not relied upon is

considered pertinent to applicant's disclosure ( See form PTO-892 attached herein ).

Applicant is reminded that in amending in response to a rejection of claims ( if the rejection involves with any applicable arts ), the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the objection made. Applicant must also show how the amendments avoid such references and objections. See 37 CFR §1.111(c).

12) Any inquiry concerning this communication or earlier communications from the examiner should be directed to TAN X. DINH whose telephone number is (703) 308-4859. The examiner can normally be reached on Monday - Friday, 8:00AM - 5:30PM.

The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair->

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direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Tan Dinh', with a long horizontal line extending to the right.

**TAN DINH**  
**PRIMARY EXAMINER**

March 31, 2004